



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/764,653 | 01/26/2004 | Alain Le-Brun | FRAV2003/0001 US NP | 8808 |

5487 7590 03/09/2006

ROSS J. OEHLER
AVENTIS PHARMACEUTICALS INC.
1041 ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

EXAMINER

BERNHARDT, EMILY B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1624

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,653

Applicant(s)

LE-BRUN ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-16, drawn to compounds and compositions where
G=piperazines and X=N, classified in class 544, subclasses such as
371 and others based on the exact nature of additional variables which
include heterocyclic rings; class 514 subclass 254.05, etc.
- II. Claims 1-13 and 16, drawn to compounds and compositions where
G=piperazines and X=C, classified in class 544, subclass 372, etc.;
class 514, subclass 254.01, etc.
- III. Claims 1,2,4-12, drawn to compounds and compositions where
G=tetrahydropyridines and X=N, classified in class 546, subclasses
such as 275.4,275.7; class 514 subclass 341, etc.
- IV. Claims 1,2 and 4-12, drawn to compounds and compositions where
G= tetrahydropyridines and X=C, classified in class 546, subclasses
such as 343, etc. , class 514 subclass 343, etc.
- V. Claims 1,2 and 4-12, drawn to compounds and compositions where G=
piperidines and X=N, classified in class 546, subclasses such as 211;
class 514 subclass 326, etc.

VI. Claims 1,2 and 4-12, drawn to compounds and compositions where G= piperidines and X=C, classified in class 546, subclasses such as 208; class 514 subclass 326, etc.

Note that claims 17-21 are nonstatutory claims (drafted in terms of “use”) and thus have not been included in any of the above groups. If amended to statutory form they will be appropriately grouped.

In addition to an election of one of the above groups applicants must also elect a single species for initial examination. Based on species elected further restriction at R1 and R2 may be required by the receiving examiner.

The inventions are distinct, each from the other because of the following reasons: The compounds of I-VI relate to compounds of considerable structural dissimilarity in view of the varying and all encompassing choices permitted at all variables except R3. There is no common core but rather a variety of monocyclics, bicyclics permitted in the main formula. Such compounds are diversely classified and are not art-recognized equivalents. Art which may anticipate or render obvious one of these groups would not necessarily do the same for those remaining based on the structural dissimilarity of I vs II vs III, etc. as a whole. The provisos present in the claims appear to be necessitated by prior art which may still be pertinent towards some of Group I subject matter.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds

one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt
Primary Examiner
Art Unit 1624